



[10191/1378]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Andreas KYNAST et al.

For: **METHOD FOR TRANSMITTING
INFORMATION AND TERMINAL
DEVICE TO RECEIVE INFORMATION**

Filed: May 15, 2000

Serial No.: 09/554,553

MAIL STOP APPEAL BRIEF
Commissioner for Patents
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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

SIR:

Appellant submits the present Reply Brief (the two-month response date for which is October 15, 2007 (since October 14, 2007 is a Sunday) to the Answer dated August 14, 2007 ("the Answer"). Although not required, two duplicate copies of this Reply Brief are also being submitted herewith as a courtesy to the Patent Office.

For the reasons explained in the Appeal Brief and those explained below, it is again respectfully submitted that the final rejections of claims 8 to 18 should be reversed for the reasons explained below, so that these claims may be allowed.

REPLY

**A. The Rejections Under 35 U.S.C. § 103(a) That Claims
8 to 14 and 16 to 18 Are Unpatentable Over the
Mankovitz Reference In View Of the Levac Reference**

Claims 8 to 14 and 16 to 18

Claims 8 to 14 and 16 to 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,949,492 (“Mankovitz”) and U.S. Patent No. 5,872,926 (“Levac”).

It is respectfully submitted that the Answer does not meaningfully address or refute the Appeal Brief. Accordingly, the following is submitted:

The claimed subject matter of claim 8 concerns a method for transmitting information between an infrastructure and data users 1, 2, the infrastructure including a service provider 3, the data users 1, 2 including terminal devices 1, 2 in a motor vehicle, the terminal devices having specific different data processing capabilities, the method including making a single data service 4 available in a standardized format, using the infrastructure, and via interfaces 6, 7 situated in the infrastructure, adapting data from the single data service 4 in the standardized format to the different data processing capabilities of the terminal devices 1, 2, wherein the different data processing capabilities of the terminal devices are identified based on at least one of a terminal device identifier and a terminal device code transmitted by a respective terminal device to the service provider. (See, for example, page 4, line 12 to page 6, line 19, and Fig. 2).

As to the claimed subject matter of claim 17, it concerns a method for transmitting information between an infrastructure and data users 1, 2, the infrastructure including a service provider 3 having a data service 4 configured independently of the processing capabilities of the data users 1, 2, the data users 1, 2 including terminal devices 1, 2 in a motor vehicle, the terminal devices 1, 2 having specific different data processing capabilities, the method including making a data service 4 available in a standardized format, using the infrastructure, via interfaces 6, 7 situated in the infrastructure, adapting data from the data service 4 in the standardized format to the different data processing capabilities of the terminal devices 1, 2, and transmitting the adapted data to a terminal device 1, 2, wherein

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the different data processing capabilities of the terminal devices 1, 2 are identified based on at least one of a terminal device identifier and a terminal device code transmitted by a respective terminal device 1, 2 to the service provider 3. (See, for example, page 4, line 12 to page 6, line 19, and Fig. 2).

Thus, claims 8 and 17 relate to methods for transmitting information between an infrastructure and data users, the data users including terminal devices in a motor vehicle. Claims 8 and 17 provide that the terminal devices have different data processing capabilities and that the method includes adapting data from a data service in a standardized format to the different data processing capabilities of the terminal devices. The data is adapted via interfaces situated in the infrastructure. Claims 8 and 17 also provide the features in which *the different data processing capabilities of the terminal devices are identified based on at least one of a terminal device identifier and a terminal device code transmitted by a respective terminal device to the service provider.*

Hence, according to claims 8 and 17 a terminal sends its own identifier or code to the service provider to allow the service provider to adapt the message to be sent to the terminal.

Claims 11, 16 and 18, as presented, relate to devices for transmitting information between an infrastructure and data users. Claims 11, 16 and 18, as presented, include features like those of claims 8 and 17, as presented.

It is respectfully submitted that Mankovitz and Levac, whether taken alone or combined, do not disclose or suggest a method or device for transmitting information between an infrastructure and data users, in which *different data processing capabilities of terminal devices of the data users are identified based on at least one of a terminal device identifier and a terminal device code transmitted by a respective terminal device to the service provider*, as provided for in the context of claims 8, 11 and 16 to 18.

Like the Final Office Action (as admitted on page 3), the Answer admits that Mankovitz does not disclose or suggest these claimed features, and instead relies on Levac at lines 3 to 21 of column 2, which merely states as follows:

Thus, in accordance with a first aspect of the invention, an integrated message system includes a plurality of types of communication devices, of which each type communicates in a

format different than the other types. The system further includes a message source, a message server and a communication device interface. The message server receives a communication generated by the message source. The communication includes a message portion and a message parameter portion, which includes information specifying a communication destination having at least one of the types of communication devices. The message server automatically dispatches the communication to the communication device interface in response to the message parameter portion. The communication device interface converts the message portion and generates at least one converted message in the format compatible with the at least one type of communication device at the communication destination. The communication device interface further transmits the at least one converted message to the communication destination.

It is simply not understood how this passage discloses the feature of the claimed subject matter in which *different data processing capabilities of terminal devices of the data users are identified based on at least one of a terminal device identifier and a terminal device code transmitted by a respective terminal device to the service provider*, as provided for in the context of claims 8, 11 and 16 to 18 – as conclusorily asserted in the Answer.

In particular, in col. 2, lines 8 to 13, Levac merely states that “[t]he message server receives a communication generated by the message source. The communication includes a message portion and a message parameter portion, which includes information specifying a communication destination having at least one of the types of communication devices.” In other words, according to Levac the message server receives all information about the destination from the message source, not from the destination. Hence, even if one were to assume that the message parameter portion includes information about the capabilities of the destination device (which Levac does not disclose or suggest), then the message source (e.g., a different device) would need to know the specific data capabilities of the destination. But such an approach is wholly different from the presently claimed subject matter, which provides that the destination send an identifier when requesting a message from the provider.

In view of the foregoing, it is respectfully submitted that even if Mankovitz and Levac are combined (the properness of which is not conceded) it does not render unpatentable claims 8, 11 or 16 to 18, as presented, so that these claims are allowable.

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Claims 9 and 10 depend from claim 8, and claims 12 to 14 depend from claim 11, and are therefore allowable for the same reasons as their base claims 8 and 11, respectively.

In sum, claims 8 to 14 and 16 to 18 are allowable for the above-stated reasons.

Accordingly, for at least these reasons, reversal of these rejections is therefore respectfully requested.

B. The Rejection Under 35 U.S.C. § 103(a) That Claim 15 Is Unpatentable Over the Mankovitz Reference In View Of the Ellis Reference

Claim 15

Claim 15 was rejected under 35 U.S.C. 103(a) as unpatentable over Mankovitz and Levac in view of U.S. Patent No. 5,699,255 ("Ellis").

It is respectfully submitted that even if it were proper to combine the references as suggested by the Final Office Action (which is not conceded) and as conclusorily asserted in the Answer, claim 15 includes features like those of the other independent claims, and is therefore allowable for essentially the same reasons, since the third-level Ellis reference does not cure the critical deficiencies of the primary references.

In view of all of the foregoing, reversal of this rejection is respectfully requested

As further regards all of the obviousness rejections discussed herein, in rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each

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claim element and it must also suggest combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Moreover, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on, whether taken alone or combined, do not suggest in any way modifying or combining the references so as to provide the presently claimed subject matter for addressing the problems and/or providing the benefits discussed herein and in the specification, as explained above.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Final Office Action's assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

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In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Office Actions to date reflect hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, it is believed that there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference relied upon makes plain that it simply does not describe the features discussed above of the claims as now presented.

More recent still, in the case of In re Lee, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a

programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

[The] "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. [The] Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion as to the reference so as to provide the subject matter of the claims and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness,

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since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper *prima facie* unpatentability case — which has not been met in the present case. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, all of claims 8 to 18 are allowable.

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CONCLUSION

In view of the above, it is respectfully requested that the rejections of claims 8 to 18 be reversed, and that these claims be allowed as presented.

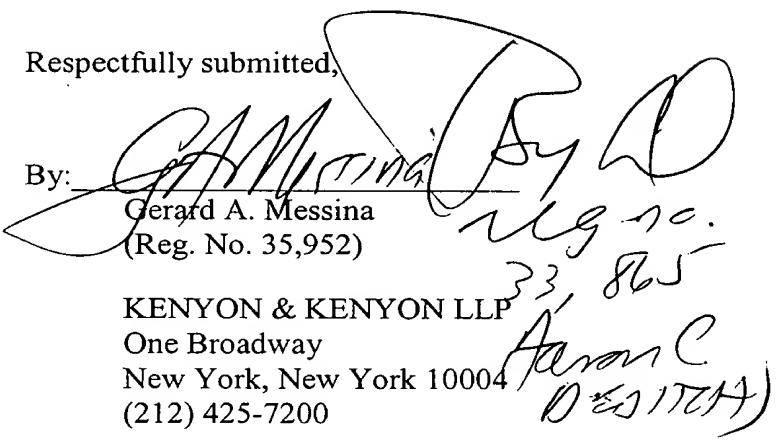
Dated: 10/15/2007

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